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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,174	06/22/2000	Trevor Hamilton	ACC0786P1US	7590

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EXAMINER

JOLLEY, KIRSTEN

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 01/21/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/599,174

Applicant(s)

HAMILTON ET AL.

Examiner

Kirsten Crockford Jolley

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 December 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29, 31-33 and 35-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29, 31-33 and 35-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Priority*

1. A certified copy of the foreign priority document must be provided by the applicant if the parent international application has not entered the national stage under 35 U.S.C. 371. See MPEP 1895.01.

### *Response to Arguments/Amendments*

2. The 35 USC 112, 2<sup>nd</sup> paragraph rejections over claims 4, 5, 10, and 30 have been withdrawn in response to Applicant's amendments to the claims. Additionally, the 35 USC 102(b) rejection of claims 30 and 34 are withdrawn in response to Applicant's cancellation of the claims.

3. Applicant's arguments filed December 23, 2002 regarding the 35 USC 103(a) rejections have been fully considered but they are not persuasive. Claims 1-29, 31-33, and 35-40 remain rejected over WO 93/13179 as set forth below.

Applicant argues that when applying a layer of a coating composition according to WO 93/13179, curing will inevitably take place, and therefore A will immediately react with B which results in a layer without latent reactivity. Applicant further argues that when applying "wet-on-wet" two layers of a coating composition according to WO 93/13179, the first layer will comprise, for a limited time, unreacted curable silicon-containing functional groups. However, as the unreacted functional groups in component A undergo reaction with component B, these temporarily unreacted silicon-containing groups will not provide latent reactivity.

The Examiner notes that claim 1 states “a coating comprising a film-forming polymer (A) carrying unreacted curable silicon-containing functional groups providing latent reactivity.” It is the examiner’s position that the functional groups on polymer (A) of WO ‘179 do provide latent reactivity. While the latent reactivity of the functional groups may only exist for a limited time until reaction occurs (as argued by Applicant), it none-the-less exists and therefore meets Applicant’s claim. The claims do not require a specific period of time of latency or that the coating has a permanent/long-term latency.

Further, it is noted that the claims require that the *functional groups* of component A have latent reactivity. This is necessarily the case in the method of WO ‘179 as the functional groups on component A exist only until reaction with component B (at which point they are reacted and become part of the condensation product), therefore they will necessarily have latent reactivity during their existence as unreacted functional groups.

As discussed in a telephone interview in February 2002, claim 1 would appear to be allowable if Applicant changed the word “comprising” in lines 3 and 5 to --consisting essentially of--.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 36-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 36-38 are vague and indefinite because in claim 5 (from which claims 36-38 depend) the hydrocarbon radical, aromatic group, and araliphatic group are listed in the alternative to one another, while claims 36-38 require *each* of a specific hydrocarbon radical, aromatic group, *and* araliphatic group. It is confusing in claim 36, for example, that R<sup>4</sup> and R<sup>5</sup> can be a hydrocarbon radical up to 7 carbon atoms, *and* a phenyl aromatic group, *and* a benzyl araliphatic group.

#### ***Claim Objections***

6. Claims 4, 10, 31, and 33 are objected to because of the following informalities: Claim 31 appears to be a duplicate of claim 4. Claim 33 appears to be a duplicate of claim 10. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

7. Claims 1-29, 31-33, and 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 93/13179.

WO 93/13179 is applied for the same reasons discussed in paragraph 8 of the Office action mailed July 6, 2001, and in the final Office action mailed May 26, 2002. The claims are additionally rejected for the reasons discussed above in paragraph 3. New claims 35-40 are rejected for the same reasons as claims 4, 5, and 10.


#### ***Conclusion***


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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten Crockford Jolley whose telephone number is 703-306-5461. The examiner can normally be reached on Monday to Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 703-308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1193.

  
kcj  
January 15, 2003

  
SHRIVE P. BECK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700